

REMARKS

Reconsideration of the present application is respectfully requested.

I. Status of the Claims

Claims 1, 2 and 7 have been withdrawn.

Claims 3-5 and 8-11 are pending.

Claim 6 has been cancelled.

II. Declaration under 37 C.F.R. § 1.132

Applicant submits the attached signed declaration by Atsushi Okita ('Okita Declaration') in support of Applicant's traverse of the non-final rejection of pending claims 3-5 and 8-11. Applicant submits that the attached declaration is responsive to the present non-final rejection and presents sufficient facts to overcome the specific rejections of the Examiner.

III. Rejections under 35 U.S.C. § 112

On page 2 of the Office Action, the Examiner has rejected claims 3-5 and 8-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter found in the present application. Specifically, the Examiner cites the lack of proper antecedent basis for the claim term "water" in the raw material solution.

Applicant has amended claim 3 so as to more clearly point out the claimed invention. Claim 3 now clearly recites that the raw material solution is dissolved into water, and that the seed crystal is also added to this mixture. The amended claim language does not contain, nor constitute new matter. In light of the foregoing amendment, the rejection under 35 U.S.C. §112, second paragraph is now moot.

IV. Rejections under 35 U.S.C. § 103(a)

Claims 3-5 and 8-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 4,544,793 to Okado in view of JP 61-058812-A.

Claim 3, as amended, recites non-obvious subject matter by reciting a process for preparing a zeolite catalyst having a particle diameter of between 0.05 - 2.0 μ m. The cited prior art, alone or in combination, fails to recite a particle diameter within the claimed range.

In the January 13, 2010 Office Action, the Examiner stated that it is well known in the art of zeolite synthesis to employ seed crystals to produce final compositions having crystals of consistent and desired particle size. [Pg. 4 of the January 13, 2010 Office Action] The Examiner cites the '812 patent as teaching that the ZSM-5 seed crystals are known to be used during the synthesis of zeolite materials. Furthermore, the Examiner considers arrival at the optimum or desired ranges to be merely a matter of routine experimentation due to the fact that the compositions of the prior art and the instant claims are similar.

Applicant points to the Experimentation Report 1 (attached to and referred to in the Okita Declaration), page 1, ¶¶ 2-4, which clearly shows the results of the process as described in the pending claims. Particularly, ¶ 2 and Fig. 2 clearly show the process as described by the present invention yielding a MFI structure zeolite having an average particle size of 1.5 μ m. Also see Okita Declaration.

Applicant also points to Experimentation Report 1, pg. 2, which details a zeolite catalyst produced by a process combining the '812 and Okado references. As shown at pg. 2, ¶¶ 4-7, the catalyst particles that result from a combination of the '812 and Okado references have an average particle size of 5.0 μ m. See Atsushi Declaration pg. 3. The Experimental Report 1 also demonstrates that the combined prior art catalyst is produced using the same size seed crystal (0.5 μ m) as used in the present claim. Atsushi Declaration, pg. 2-3. It is also clear that the variables not directly specified by the prior art are identical to the present invention (i.e. the catalyst precursor was agitated at 160°C for 18 hours, then dried at 120°C for 5 hours and then heated at 520°C for 10 hours.) Therefore, the produced catalyst is attributable to the difference between non-obvious

subject matter of the pending claims and the cited prior art. Fig. 3 clearly shows that the particles produced by a combination of the prior art are significantly larger than those produced by the instant claims.

Pending claim 3 of the present application recites a catalyst particle having an average diameter of 0.05- 2 μ m. Experimentation Report 1 clearly shows the cited prior art, in any obvious combination, fails to teach a catalyst particle diameter having this range. A person skilled in the art could not employ only “routine experimentation” and hope to achieve the range described in amended claim 3. Specifically, in order to achieve the range as described in claim 3, there would be need to be a directed effort to obtain that range. The Experimental Report 1 clearly shows that combining the prior art references results in an average particle diameter that is 3 times that which is found in the amended claim 3. While it is true that the prior art and the instant claims have the same utility, the experimental evidence clearly shows that without “undue experimentation” the two processes do not produce the same product. One skilled in the art would need to modify a number of variables relating to the composition before a similar result would be obtained. Additionally, one skilled in the art would need to employ a seed crystal with characteristics similar to those disclosed in the instant patent. The Examiner has failed to provide prior art, alone or in combination that provides these modified characteristics.

The combined prior art fails to teach the complete invention as envisioned by amended claim 3. Therefore, it is impossible for the cited prior art to render claim 3 obvious. Furthermore, the pending claims 4-5 and 8-11 depend directly or indirectly from claim 3. As such, those claims are similarly non-obvious in view of the cited prior art.

CONCLUSION

In view of the above discussion, applicant believes the pending application is in condition for allowance. It is believed that all of the stated grounds of rejections have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections.

It is believed that no fees are required with this submission; however, if it should be determined that fees are required, the Commissioner is hereby authorized and requested to charge any needed fees (to include extension-of-time fees) to Deposit Account No. 50-4570, and Applicants hereby petition for any needed extension of time.

Dated: June 14, 2010

Respectfully submitted,

By 

Jordan G. Garner
Registration No.: 60148
LEASON ELLIS LLP.
81 Main Street, Suite 503
White Plains, New York 10601
(914) 288-0022(Tel)
(212) 288 0023(Fax)
Attorneys/Agents For Applicant